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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,046	09/30/2003	Michael P. Whitman	11443/158	7736
26646	7590	12/01/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,046

Applicant(s)

WHITMAN, MICHAEL P.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 74 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 74, "irrigation/aspiration channel" lacks antecedent basis. It appears that this claim should depend from claim 73. This rejection is being repeated from the previous Office Action.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 29-32, 35-64 and 67-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk et al. (WO 93/15648) for the reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 05262005.

As for the newly added limitations regarding the shaft being sealed, Wilk et al. teaches that the channel that receives the optical guide member is "closed at the distal end" (page 5, fourth full paragraph) (note window 28 in Figure 3 for example) and that the "present endoscope is easier to clean and maintain in a sterile condition" (page 5, fifth full paragraph). This suggests to the reasonable person that the window at least partly seals the shaft, otherwise the optical

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guide member would not remain in a sterile condition. Since the newly added subject matter set forth the condition for being sterilized as being "sealed", at least the sealed shaft will meet this limitation. It is noted that the optical guide member (20) would also appear to be sealed at least at the distal end, and thus, as per the newly added subject matter, sterilizable. There is no reason to believe that any portion of the Wilk et al. device could not be sterilized or autoclaved, even though that might not be intended.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-8, 10-28, 33, 34, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk et al. in view of Kanno et al. (U.S. Pat. 4,884,133) for the reasons set forth in numbered paragraph 10 of the previous Office Action, paper number 05262005.

### ***Response to Arguments***

7. Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive.

It appears on page 16 of Applicant's remarks that Applicant is suggesting that since Wilk et al. does not disclose the specifics as set forth in Applicant's specification (e.g., the particular material forming the sheath), it does not meet the limitations of the claims. However, Applicant's claims are not *claiming* any specific material forming the sheath. And it must be pointed out that

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"PTFE", silicone, SIL-KORE and EPTFE, to name only a few, are materials that are known and used in the endoscope art to form the sheath or insertion section of the endoscope. If Applicant really believes that these materials have never been contemplated for such particular use, the Examiner would be more than happy to cite prior art patents contradicting such belief.

In addition, even though Applicant suggests that "conventional endoscopes typically can not be sterilized", it also must be pointed out that, at least in the prior patents (not counting non-patent literature), there are many endoscopes that can and there are many suggestions to do so, dating back for many years. If Applicant decides to claim structure related to the sterilization feature (besides being sealed *since almost every endoscope* is inherently sealed to a certain extent to prevent fluids from the body from invading the interior and contaminating such expensive devices), the Examiner will address these features when presented in the claims.

Regarding the Wilk et al. reference, Applicant argues one-sidedly that Wilk's statement "there is no need to subject optical guide member 20 to sterilizing and cleaning operations which may damage the optical guide and eventually wear it down" supports Applicant's contention that the Wilk et al. device is not sterilizable or autoclavable. However, Applicant, not surprisingly, fails to mention what this statement also suggests: that the optical guide will not necessarily be damaged ("**may** be damaged") and, more importantly, can at least be sterilized at least once since it may "**eventually**" wear down. Furthermore, it would not be unreasonable to assume that all components are sterilized or autoclaved at least once before use since no practitioner would knowingly insert an unsterile device into a patient.

In any event, the intended use of the device of Wilk et al. and Applicant's alleged invention is not at issue here. The Examiner continues to maintain that the structural elements of the claims are met by Wilk et al., as broadly as claimed.

Again it is importantly noted that the Wilk et al. reference was only applied to the claims to maximize the number of claims that could be met by any particular reference. Although Wilk et al. is a relevant reference, there are many references cited in the previous Office Action that, alone or in combination, **meet the limitations of at least the independent claims**. Applicant is **strongly urged** to figure out what he has invented and make the claim language reflect what is believed to be patentable, **using the cited prior art of record as a guide**. This will greatly aid the Examiner in citing and applying references that are more specifically directed to what Applicant believes is the invention.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

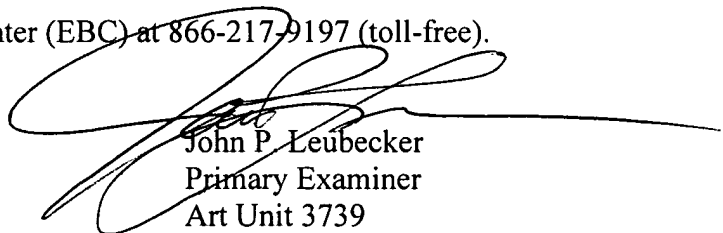
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl